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Paper No. 7

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OFFICE OF PETITIONS

In re Application of :
Richard B. Olsen, Michel M. Dacorogna, Oliver V. :
Pictet, Ulrich A. Muller, Rakhal D. Dave, and Lars A. :
Jaegar :
Application No. 09/855,633 : **DECISION ON PETITION**
Filed: May 14, 2001 :
Attorney Docket No. 10366-009 :
Title: METHODS FOR TRADE DECISION MAKING :

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed February 13, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

On May 14, 2001, the application was deposited, identifying Richard B. Olsen, Michel M. Dacorogna, Oliver V. Pictet, Ulrich A. Muller, Rakhal D. Dave, and Lars A. Jaegar as joint inventors. The application was deposited without a fully executed oath or declaration. On July 12, 2001, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that an executed oath or declaration and a surcharge of \$65.00 were required. This Notice set a two-month period for reply.

With the instant petition, the petitioner has included the filing fee for the petition, the \$65.00 surcharge, a four month extension of time to make timely this reply², a declaration executed by each inventor save Inventor Pictet, a copy of an e-mail sent by the non-signing inventor, and a copy of the letter sent to the petitioner from the non-signing inventor's attorney.

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR §1.63.

² A five month extension of time was required. The difference has been charged to petitioner's Deposit Account, as authorized in the petition.

Petitioner has met requirements (1), (2), (3), and (6) of 37 C.F.R. §1.47(a) above.

Regarding the fourth requirement, petitioner has not shown that a *complete* copy of the application was sent to the non-signing inventor. Petitioner refers to attorney Ulmann's allegation that certain references were not mentioned in the application to show that a copy of the entire application was received by attorney Ulmann. This is insufficient to show, as required, that Rule 47 applicant presented the inventor with a copy of the entire application.

Regarding the sixth requirement above, it follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed³.

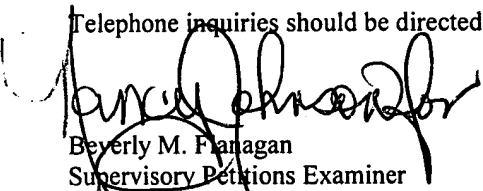
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Crystal Plaza 4, Suite 3C23
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Telephone inquiries should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

³ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).